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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/344,863 06/28/99 SCHLUETER

E D/99006

EXAMINER

IM22/0830

JOHN E BECK  
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XEROX SQUARE 20A  
ROCHESTER NY 14644

HON, S

ART UNIT

PAPER NUMBER

1772

DATE MAILED:

08/30/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Office Action Summary**

Applicant N .

09/344,863

Applicant(s)

SCHLUETER ET AL.

Examiner

Sow-Fun Hon

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06/26/00.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 4-26 is/are pending in the application.
- 4a) Of the above claim(s) 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 26 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

**Attachment(s)**

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

***Election/Restrictions***

1. Applicant's election with traverse of claims 1-25 in Paper No. 3 (filed 06/26/00) is acknowledged. The traversal is on the ground(s) that a xerographic component cannot be used in an electrolytic capacitor. This was deemed unpersuasive because Applicant has failed to provide convincing arguments that the product could not be used as an electrolytic capacitor. Although Applicant is calling the product a xerographic component, it is only made up of a fluoropolymer substrate coated with polythiophene.

2. In the event the examiner finds claims 1, 4-25 allowable, consideration will be given to claim 26. Where product and process claims drawn to independent and distinct inventions are presented in the same application, Applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or process. See MPEP § 806.05(f) and § 806.05(h). The claims to the nonelected invention will be withdrawn from further consideration under 37 CFR 1.142. See MPEP § 809.02(c) and § 821 through § 821.03.

However, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined. Where the application as originally filed discloses the product and the process for making and/or using the product, and only claims directed to the product are presented for examination, when a product claim is found allowable, applicant may present claims directed to the process of making and/or using the patentable product by way of amendment pursuant to 37 CFR 1.121. Where no additional fee

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is paid, if the elected invention is directed to the product and the claims directed to the product are subsequently found patentable, process claims which either depend from or include all the limitations of the allowable product will be rejoined. See MPEP 821.04.

The requirement is still deemed proper and is therefore made FINAL.

### ***Rejections Withdrawn***

3. The 35 USC § 102 rejection in Paper # 2, paragraph 7 (mailed 05/24/00) of original claims 1-3, 5-8, 24-25 in Paper # 2 (filed 06/28/99) have been withdrawn due to Applicant's Amendment in Paper # 3 (filed 06/26/00).

### ***Rejections Repeated***

4. The 35 USC § 103 rejection of claims 1-3, 5-13, 16-18, 20-22, 24-25 as being unpatentable over Tarumi et al. in view of Jonas et al. has been repeated for reasons previously of record in Paper # 2, paragraph 9 (mailed 05/24/00). See paragraph 7 below.

5. The 35 USC § 103 rejection of claims 4, 19, 23 as being unpatentable over Tarumi et al. of Jonas et al. and Newkirk has been repeated for reasons previously of record in Paper # 2, paragraph 10 (mailed 05/24/00). See paragraph 8 below.

6. The 35 USC § 103 rejection of claim 4 as being unpatentable over Tarumi et al. of Jonas et al. and Chen et al. has been repeated for reasons previously of record in Paper # 2, paragraph 11 (mailed 05/24/00). See paragraph 9 below.

7. The 35 USC § 103 rejection of claims 14-15 as being unpatentable over Tarumi et al. of Krafft et al. has been repeated for reasons previously of record in Paper # 2, paragraph 12 (mailed 05/24/00). Krafft et al. teach that the inherently conductive coatings are used in areas

which require good electrical conductivities (column 3, lines 5-6). See paragraph 10 below.

***Response to Arguments***

8. Applicant's arguments in Paper # 3 (filed 06/26/00) regarding the 35 USC § 103 rejections of claims 1, 5-13, 16-18, 20-22, 24-25 as being unpatentable over Tarumi et al. in view of Jonas et al. have been fully considered but are deemed unpersuasive. Tarumi et al. have a generic conductive layer which could be made from the conductive coating of Jonas et al. since Jonas et al. teach the use of the coatings in areas which require good electrical conductivities (Jonas et al., column 3, lines 5-6). These are analogous art since both Tarumi et al. and Jonas et al. teach components of electrophotography (Jonas et al., col. 3, line 5-15). Applicant is reminded that electrophotography is commonly called xerography, and that the accepted definition of xerography is the process for copying graphic matter by the action of light on an electrically charged photoconductive insulating surface in which the latent image is developed with a resinous powder. Therefore it would have been obvious to one of ordinary skill in the art to look for the teachings in Jonas et al. to provide for the deficiencies of Tarumi et al.

9. Applicant's arguments in Paper # 3 (filed 06/26/00) regarding the 35 USC § 103 rejections of claims 4, 19 and 23 as being unpatentable over Tarumi et al. in view of Jonas et al. and Newkirk have been fully considered but are deemed unpersuasive. Tarumi et al. and Jonas have been discussed above. In addition, Tarumi et al. have a generic fluoropolymer intermediate layer which could be made from the specific oil and toner-resistant, wear-resistant, flexible fluoropolymers of which the intermediate layer taught by Newkirk is comprised. Applicant has

failed to provide convincing arguments that the function of the intermediate layer in the roller of Tarumi et al. is not the same as that of the one in the roller of Newkirk.

10. Applicant's arguments in Paper # 3 (filed 06/26/00) regarding the 35 USC § 103 rejections of claim 4 as being unpatentable over Tarumi et al. in view of Jonas et al. and Chen have been fully considered but are deemed unpersuasive. Jonas and Tarumi et al. have been discussed above. The generic fluoropolymer intermediate layer of Tarumi et al. could be made from the specific fluoroelastomer of which the base cushion layer taught by Chen is comprised of. Applicant has failed to provide con convincing arguments that the function of the intermediate layer in the roller of Tarumi et al. is not the same as that of the base cushion layer in the roller of Newkirk.

11. Applicant's arguments in Paper # 3 (filed 06/26/00) regarding the 35 USC § 103 rejections of claims 14-15 as being unpatentable over Tarumi et al. in view of Krafft et al. have been fully considered but are deemed unpersuasive. Tarumi et al. has been discussed above. Krafft et al. teach that polythiophenes have a combination of the following advantages: Electronic conductivity with little intrinsic colour, permanence of conductivity after processing and independence of the conductivity from the relative humidity of the atmosphere (column 2, lines 50-55).

### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Sow-Fun Hon whose telephone number is (703)308-3265. The examiner can normally be reached Monday to Friday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ellis Robinson, can be reached on (703)308-2364. The fax phone number for the organization where this application or proceeding is assigned is (703)305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

STA  
08/25/00

  
RENA L. DYE  
PRIMARY EXAMINER  
TC 1200